

Notice of Allowability

Application No.

09/780,402

Examiner

Callie E. Shosho

Applicant(s)

YAMANOUCHI ET AL.

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment filed 11/14/03.
2. ☒ The allowed claim(s) is/are 1-5 and 8-23.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No. _____.
 - (b) ☐ including changes required by the proposed drawing correction filed _____, which has been approved by the Examiner.
 - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the margin according to 37 CFR 1.121(d).

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|---|
| 1 <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 5 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6 <input type="checkbox"/> Interview Summary (PTO-413), Paper No. _____ |
| 3 <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No. _____ | 7 <input type="checkbox"/> Examiner's Amendment/Comment |
| 4 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8 <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9 <input type="checkbox"/> Other |

Callie E. Shosho
Primary Examiner
Art Unit: 1714

Statement of Reasons for Allowance

1. The present claims are allowable over the "closest" prior art Sacripante et al. (U.S. 6,025,412), Tsutsumi et al. (U.S. 6,031,019), JP 09059552, and JP 03231975 for the following reasons:

Sacripante et al. disclose an aqueous ink jet ink and method of ink jet printing wherein the ink comprises colored particles dispersed in a liquid medium and wherein the colored particles comprises oil-soluble polymer including polyamide and polyester comprising ionic group and oil-soluble dye. There is also disclosed a method of making the colored particles wherein the polymer, dye, and solvent are added to water and then emulsified. There is further disclosed an ink jet printing method wherein the above described ink is added to ink jet printer. However, there is no disclosure or suggestion in Sacripante et al. of specific oil-soluble dye as required in the present claims. Further, it is disclosed that the dye is chemically attached to the polymer either by incorporation into the base resin chain or as a side chain constituent. However, this is in direct contrast to the present claims that require that the oil-soluble dye and the polymer are separate compounds. Additionally, it is noted that Sacripante et al. teach against using the dye and polymer as separate compounds. Specifically, col.3, lines 35-45 of Sacripante et al., disclose that present quality is improved and intercolor bleed reduced when the dye is chemically attached to the polymer.

Tsutsumi et al. disclose a water-based ink jet ink and method of ink jet printing wherein the ink comprises polymer particles colored with oil-soluble dye wherein the polymers include polyurethane and polyester comprising ionic groups. There is also disclosed a method of making

the colored particles wherein the polymer, dye, and solvent are added to water and then emulsified. There is further disclosed an ink jet printing method wherein the above described ink is added to ink jet printer. However, there is no disclosure or suggestion of specific oil-soluble dye as required in all the present claims.

In order to meet the limitation regarding the specific oil-soluble dye, Tsutsumi et al. was combined with either JP 09059552 or JP 03231975 which each disclose the use of oil-soluble dye as presently claimed. However, there is no disclosure or suggestion in either JP 09059552 or JP 03231975 of polymer selected from the group consisting of polyurethane, polyester, polyamide, polyurea, and polycarbonate as required in all the present claims.

The above is especially significant in light of applicants' 1.132 declaration filed 11/14/03 wherein ink within the scope of the present claims, i.e. comprising presently claimed dye and polymer, is compared with ink outside the scope of the present claims but within the scope of Tsutsumi et al., i.e. comprising presently claimed polymer but different oil-soluble dye. It is shown that the ink of the present invention is superior in terms of stability with time. Thus, the declaration is successful in establishing unexpected or surprising results over the cited prior art.

Thus, it is clear that Sacripante et al., Tsutsumi et al., JP 09059552, or JP 03231975, either alone or in combination do not disclose or suggest the present invention.

In light of the above, it is clear that the rejections of record are untenable and so, the present claims are passed to issue.

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Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

NOTE: A copy of the Notice of References Cited (PTO-892) attached to the office action mailed 11/22/02 is attached to the present office action per request of applicants.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Callie E. Shosho
Primary Examiner
Art Unit 1714

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12/3/03